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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,389	04/20/2001	Daniel C. Castle	10006967-1	2509

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EXAMINER

LAstra, DANIEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,389

Applicant(s)

CASTLE, DANIEL C.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/20/01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-22 have been examined. Application 09/839,389 (BACKGROUND ADVERTISING IN AN INTERNET ENVIRONMENT) has a filing date 04/20/2001.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 2 and 5 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found

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that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claim 1 recite "useful, concrete and tangible result" (A method for displaying advertisements), however, again, the claim recites no structural limitations (i.e., computer implementation), and so it fails the first prong of the test (technological arts). Dependent claims 2 and 5 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 5-7, 9, 12 and 14-16 rejected under 35 U.S.C. 102(e) as being anticipated by Gabbard et al (U.S. 6,205,432).

As per claim 1, Gabbard teaches:

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A method for displaying advertisements comprising the steps of displaying informational content on a first layer (see column 4, lines 5-67); and

displaying advertisement content behind the informational content, on a second layer, such that both the informational content and the advertisement content are viewable simultaneously (see column 4, lines 5-67).

As per claim 2, Gabbard teaches:

The method of claim 1 and further including the step of displaying both the first and the second layers on a monitor device such that both layers are viewable simultaneously (see column 4, lines 5-67).

As per claim 5, Gabbard teaches:

The method of claim 1 and further including the step of displaying related advertisement content on the first layer, the advertisement content on the second layer and the related advertisement on the first layer being related by a common product or service (see column 10, lines 1-25).

As per claim 6, Gabbard teaches:

A method for displaying an advertisement over the Internet to a computer device, the method comprising the steps of:

transmitting a first layer, comprising informational content, to a client process (see column 4, lines 6-67);

and

transmitting a second layer, comprising advertisement content, to the client process such that both the informational content and the advertisement content are viewable simultaneously (see column 4, lines 6-67).

As per claim 7, Gabbard teaches:

The method of claim 6 and further including the step of the client process requesting delivery of the first and second layers (see column 4, lines 37-67).

As per claim 9, Gabbard teaches:

The method of claim 7 wherein the client process is resident on a personal computer comprising a monitor device (see column 4, lines 60-67).

As per claim 12, Gabbard teaches:

A World Wide Web server system for displaying an advertisement over the Internet to a client process, the system comprising:

memory that stores data for processing;

storage media that has a capability to store software processes, a plurality of informational content, and a plurality of advertisement content;

input/output devices that provide access to the Internet for the server system;

and a processor that controls the system, the processor coupled to the memory, the storage media, and the input/output devices, the processor having means for reading a first informational content and a first advertisement content from the storage media and transmitting the first informational content in a first layer and the first advertisement content in a second layer. Claim 12 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 14, Gabbard teaches:

The system of claim 12 wherein the storage media stores information relating to the client process (see column 7, lines 1-32).

As per claim 15, Gabbard teaches:

The system of claim 14 wherein the processor has means for determining an advertisement content from the plurality of advertisement content in response to the information relating to the client process (see column 10, lines 1-25).

As per claim 16, Gabbard teaches:

The system of claim 12 wherein the client process is an automatic content delivery service that requests information content from predetermined Internet resources (see column 10, lines 1-26).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (U.S. 6,205,432).

As per claim 3, Gabbard teaches:

The method of claim 1 but fails to teach and further including the step of printing both the first and the second layers on a page such that both layers are viewable simultaneously. However, Official notice is taken that it is old and well known in the

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computer art to print a image that is displayed in the active area of a computer screen. It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention was made to know that a image consisting of a content with a background advertisement that is displayed in a computer screen would be printed using a computer printer.

As per claim 4, Gabbard does not expressly teach:

The method of claim 3 wherein both the first and the second layers are printed substantially simultaneously. However, the same rejection applied to claim 3 is applied to claim 4.

As per claim 8, Gabbard teaches:

The method of claim 6 and further including the step of printing the first and second layers. The same rejection applied to claim 4 is applied.

Claims 10, 11, 13 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (U.S. 6,205,432) in view of Anderson (U.S. 6,532,039).

As per claim 10, Gabbard teaches:

The method of claim 7 but fails to teach and further including the step of the client process requesting a predetermined level of transparency of the second layer. Anderson teaches a system that allows to specify the level of transparency of a background image (see column 8, line 50- column 9, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gabbard would adjust the level of transparency of a background advertisement, as taught by Anderson. Adjusting the level of transparency would allow

to adjust the contrast between the content and the background image displayed in the computer screen.

As per claim 11, Gabbard and Anderson teach:

The method of claim 10 and further including the step of the transparency of the advertisement content being adjusted to the predetermined level in response to a composition of the computer device. Anderson teaches the image display would be adjusted depending upon the display interface (see column 8, lines 42-67). Therefore, the same rejection applied to claim 10 is applied to claim 11.

As per claim 13, Gabbard and Anderson teach:

The system of claim 12 but fails to teach wherein the processor comprises means for adjusting a predetermined level of transparency of the second layer such that the first layer and the second layer can be viewed simultaneously. Claim 13 contains the same limitations as claim 11 therefore the same rejection is applied.

As per claim 17, Gabbard and Anderson teach:

A method for transmitting advertising content over the Internet from a server to a client process operating on a computer device, the method comprising the steps of receiving a request for predetermined information content;

accessing the predetermined information content from memory; accessing the advertising content having a predetermined transparency level;

adjusting the predetermined transparency level of the advertising content;

combining the advertising content with the predetermined information content to form a Web page; and

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transmitting the Web page to the client process. Claim 17 contains the same limitations as claim 13 therefore the same rejection is applied.

As per claim 18, Gabbard and Anderson teach:

The method of claim 17 wherein the request for predetermined information content is transmitted by the client process (see column 10, lines 1-26).

As per claim 19, Gabbard and Anderson teach:

The method of claim 17 but fails to teach wherein the transparency level is adjusted in response to capabilities of the computer device. However, the same rejection applied to claim 11 is applied to claim 19.

As per claim 20, Gabbard and Anderson teach:

A method for transmitting advertising content over the Internet from a server to a client process operating on a computer, the method comprising the steps of:

receiving a request for predetermined information content;

accessing a Web page, comprising the predetermined information content in front of the advertising content, from memory, the advertising content comprising a transparency level;

adjusting the transparency level of the advertising content; and transmitting the Web page to the client process. Claim 20 contains the same limitations as claim 13 therefore the same rejection is applied.

As per claim 21, Gabbard and Anderson teach:

The method of claim 20 and further including the step of the client process displaying the Web page such that the information content and the advertising content

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are viewable simultaneously. Claim 21 contains the same limitations as claim 13 therefore the same rejection is applied.

As per claim 22, Gabbard and Anderson teach:

The method of claim 20 wherein the transparency level is adjusted in response to capabilities of the computer device. Claim 22 contains the same limitations as claim 19 therefore the same rejection is applied.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

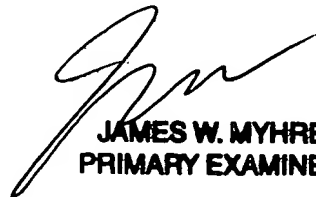
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra

September 4, 2004



JAMES W. MYHRE
PRIMARY EXAMINER